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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,055

06/02/2005

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EXAMINER

KURTZ, BENJAMIN M

ART UNIT

PAPER NUMBER

1797

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,055	Applicant(s) CAVALLINI ET AL.	
	Examiner BENJAMIN KURTZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 7 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 2 contains a reference to the claim numbers. Because claim numbers change during prosecution it is improper to reference claim numbers in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the marginal region of the filter material encompassed in the frame". There is insufficient antecedent basis for this limitation in the claim. The marginal region is not clearly defined as to what structurally defines this region.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. If the intermediate layer contained an aperture then the filter material would essentially be bypassed, the membrane would leak and the filter would be inoperative.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Goudaliez EP 0526678.

Regarding claim 1, Goudaliez teaches a filter comprising: an outer sheath (9, 10), at least one intermediate layer (12), an inlet chamber (13) in communication with an inlet (15), an outlet chamber (14) in communication with an outlet (16), a filter material (11) separates the inlet chamber from the outlet chamber and the filter material is encompassed between the outer sheath and the intermediate layer (fig. 2, 4, abstract)

Regarding claims 2-4, 6, 10 and 13, the outer sheath is made of flexible material (abstract); the outer sheath consists of two parts (9, 10) welded to one another (abstract); the filter material is encompassed between the outer sheath on the inlet side and the intermediate layer (fig. 2, 4); the intermediate layer consists of flexible material (abstract); a plurality of intermediate layers (17, 18) are provided (fig. 2, 4); and the

outlet consists of a cylindrical stub which is welded to the outer sheath and whose longitudinal axis extends in a plane which extends parallel to the plane formed by the filter material and is offset with respect to it (fig. 2).

5. Claims 1-6, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lynn et al. US 2003/0209479.

Regarding claim 1, Lynn teaches a filter comprising: an outer sheath (b, d), at least one intermediate layer (the middle layer shown in figure 4), which is a component of a frame, an inlet chamber in communication with an inlet, an outlet chamber in communication with an outlet, a filter material (28) separating the inlet chamber from the outlet chamber, the filter material is encompassed between the outer sheath and the intermediate layer (fig. 4, 5).

Regarding claims 2-6, 11 and 12, Lynn further teaches the outer sheath is made of a flexible material (abstract); the outer sheath consists of two parts welded to one another the filter material encompassed between one of these parts and the intermediate layer (abstract, fig. 4, 5); the filter material is encompassed between the outer sheath on the inlet side and the intermediate layer (fig. 4, 5); the filter material is welded to the outer sheath and the intermediate layer (fig. 5, paragraph 92); the intermediate layer consists of a flexible material (paragraph 50); the filter material is elliptic in its plan view (paragraph 56); and the inlet consists of a stub (a) which is welded to the outer sheath and which has two limbs which are arranged at right angles

to one another and of which the limb welded to the outer sheath extends substantially perpendicular from the outer sheath (fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goudaliez '678 or Lynn '479 in view of Pall US 4 976 861.

Goudaliez and Lynn teach the filter of claim 1 but do not teach the filter material being pressed or needled. Pall teaches a filter comprising a filter material that is needled (col. 20, lines 46-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a needled filter material because a needled filter provides easy entry and good retention (col. 21, lines 5-15).

Allowable Subject Matter

7. Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 7, the prior art of Goudaliez '678 teaches a first inwardly

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disposed welding seam connecting the intermediate layer to the filter material and a second outwardly disposed welding seam that connects the intermediate layer to the outer sheath. Gourdaliez does not teach the first seam connecting the filter material to the intermediate layer **and** to the outer sheath. Lynn '479 teaches a first inwardly disposed welding seam connecting the filter material to the intermediate layer and to the outer sheath and a second outwardly disposed welding seam that connects the outer sheath. Lynn does not teach the second seam connecting the intermediate layer to the outer sheath. It would not have been obvious to one of ordinary skill in the art to combine these teachings to have the first seam connect the filter material to both the intermediate layer and the outer sheath **and** to have a second seam to connect the intermediate layer to the outer sheath.

Claim 9 is allowable as depending from claim 7.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz
Examiner
Art Unit 1797

1/31/08 /BK/

/Krishnan S Menon/
Primary Examiner, Art Unit 1797